

Appl. No. 10/026,092
Amdt. dated
Reply to Office Action of June 23, 2003

Remarks

Applicant has amended the specification, claim 1, and the drawings along the lines suggested by the Examiner, and it is believed these amendments will render all objections moot.

The Examiner next rejects claims 1 and 5-10 under 35 USC 102(b) as anticipated by UK Patent No 2, 157, 755. This rejection is traversed.

The Examiner states:

"UK reference shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (no numbered), an upright (5,6) engaged to each arm, each upright having a top lateral sleeve (11), an upper cross member (4) and a lower cross member (16) engaged to and between uprights, said upper cross member having ends being slideable received by the sleeves (11) on the uprights, the arm having a flat portion being secured to a roof, the arm having a structure such as a brace (17) for mounting scaffolding thereover, and at least one net (18) stretched between and fixed to the uprights and cross members, wherein the net is removably secured to the upright and cross members by cooperating securement devices such as hooks which inherently via eyes (see lines 87-88) for providing a safety feature to prevent an operative from falling from the roof of a building."

This is an imprecise reading of the teachings of the UK Patent.

A correct reading shows that not one, but two frameworks are required, one to each side of the ridge of the roof, the frameworks being engaged to each other pivotably along the ridge to maintain the frameworks on the roof. Applicant has no such structure nor does he need one.

Further, the number of structures required by the UK embodiment are extensive, whereas applicant accomplishes the goal with a minimized number of structures, particularly since no duplication on the other side of the ridge is required to maintain his structure secured to the roof.

There cannot be any anticipation here since such a complex, duplicitous structure cannot possibly anticipate a simpler structure.

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Here see: In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990):

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference... These elements must be arranged as in the claim under review,..."

Accordingly this rejection cannot stand.

Next the Examiner rejects claims 1, 5-8 and 11 under 35 USC 102(b) as anticipated by Elkins et al. This rejection is traversed.

The Examiner states:

"Elkins et al. shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (16) each having a flat portion (38) being mounted to a roof, an upright (40) engaged to the flat portion of each arm, each upright having a top and bottom lateral sleeve (48,49), an upper cross member (20) and a lower cross member (22 or 24) engaged to and between uprights, said cross members each having ends being secured to the sleeves of the uprights by pins (44,50), the arm having a structure such as a brace (41) for mounting scaffolding thereover, and at least one net (28) stretched between and fixed to the uprights and cross members by suitable securement device."

First of all, Elkins et al. does NOT disclose a roof retaining apparatus. The title in fact reads CROWD CONTROL BARRIER.

This cannot in any manner be construed as analogous art. Here see: The Anderson Company et al. v. Trico Products Corporation, (DC WNY) 118 USPQ 49 1958:

"Although patented device is not anticipated by any prior device, practically every component of patented combination can be found among prior devices; also, it is noted that patent is limited on its face by its title; hence, claims must be construed with some strictness."

The rejection further fails in that the base member 38 of brace means 16 is not adapted to be fixed to anything and the knee brace 41 of the brace means 16 is incapable of holding scaffolding at a functional angle, for use in the environment to which applicant's device pertains.

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It is too far a stretch of the imagination to find the CROWD CONTROL BARRIER anticipating any roof retaining apparatus. Here see: King Instrument Corp., v. Otari Corp., 226 USPQ 402 (Fed. Cir. 1985):

"A reference is not available under 35 USC 103 if it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved."

and also see: In re Benno, 226 USPQ 683 (Fed. Cir. 1985):

"In dismissing Dante as a reference, the court pointed out that Dante did not even hint at the problem the appellants sought to solve. Dante would not even have encountered the problem because it would not have appeared in what he was doing."

This rejection has no solid evidentiary base and must be withdrawn.

Next, claims 1-7, 9, 11, 14 and 15 are rejected under 35 USC 103(a) as unpatentable over Probst in view of UK Patent No 2, 157, 755. This rejection is traversed.

The Examiner states:

"Probst shows and discloses a roof retaining apparatus comprising a framework including at least two angulated arms (5), each arm having a flat portion (6) having a plurality of angular slots (10) at a free end of the flat portion to engage with fasteners such as nails (9) for securing the arm to a roof (8), each arm having an upstanding flange (21) forming a channel-shaped bracket that provides a structure for mounting scaffolding (22) thereon, the upstanding flange (21) having a vertical sleeve (15) attached thereon, an upright (24) having an end being received and engaged by the vertical sleeve to each of the arms, each upright having at least a pair of lateral sleeves (26,28), an upper cross member (27) and a lower cross member (29) each having ends being slideable received by the sleeves (26 or 28) on the uprights respectively, said each sleeve having bores receiving with a pin (30) therein to engage and secure the ends of cross members to the uprights. Probst fails to define the roof retaining apparatus including a net stretched between and fixed to the uprights and the cross members as claimed. UK reference

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teaches a roof retaining apparatus comprising a framework including uprights and cross members, and a net having securement device such as hooks (19, 20) along the edges of the net to hang the net pivoting from an upper cross member and rest against a lower cross member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst having a net hooked and stretched between the and fixed to the framework at taught by UK reference for providing a safety features for preventing an operative falling from the roof of the building."

Probst actually discloses a safety barricade which can be used as a safety railing or low level parapet with his railing being pivotable relative to the roof to maintain the railing vertical. The support structures for the barricade are located outwardly of the roof. Probst also states that plywood or panel boards could be supported by the uprights to keep debris, etc. from falling through the openings between his uprights.

Inapplicability of the UK patent to the teachings herein has been argued above and is reiterated here.

The Examiner's comment regarding the obviousness of incorporating the netting of the UK patent into the Probst structure is not well taken inasmuch as Probst makes his own choice to use plywood or panels. Thus, the MOTIVATION to make the replacement proposed by the Examiner is lacking.

Here see: King Instrument Corp., v. Otari Corp., 226 USPQ 402 (Fed. Cir. 1985):

"In the absence of evidence that suggests the desirability of combining references in a proposed manner, such combination is not available to preclude patentability under 36 USC 103."

and also see: In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) "

"Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, [t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

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This rejection fails on its merits and must be withdrawn.

Next claims 8 and 10 are rejected under 35 U.S.C. 103(a) as unpatentable over Probst, UK '755 as applied to claim 1 and further in view of Brueske. This rejection is traversed.

The Examiner states:

"Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the roof retaining device having the upright and cross members having cooperating securement devices comprise eyes to be attached by the securement devices along the edges of a net. Brueske teaches a roof safety device comprising a framework including uprights mounted on a roof, a net having hooks (76) forming a securement device mounted along the edges of the net, and the uprights each having a plurality of eyes providing cooperative securement device for receiving the hooks of the net. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having cooperative securement device such as eyes mounted along the framework to receive hooks formed along the edges of the net as taught by UK reference, as a well know removable cooperative mounting mechanism, for removably securing the net to the framework to provide a safety device to the roof retaining apparatus."

Applicant has no idea what the Examiner is talking about with reference to Brueske.

There is no net in Brueske and the hooks 75 are on turnbuckles 76 which are used to engage sections of the Brueske device together. In fact, rather than thinking of using nets, safety harnesses or belt attachment cables 78 are provided. Clarification is required with regard to the Examiner's comments about structures which do not exist in Brueske.

In applicability of Probst and UK '755 set forth above are reiterated here. Here see: Datascope Corp., v. SMEC, Inc., 776 F.2d 320, 227 USPQ 838 (Fed. Cir. 1985):

"Whether prior art disclosures could physically be substituted in a combination like that claimed in the patent

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is irrelevant in determining obviousness under Section 103."

Based on these arguments, the rejection must fall by the wayside since there can be no motivation to reconstruct when structures are ABSENT from any teachings.

Finally, claims 12-13 and 16-17 are rejected under 35 U.S.C. 103(s) as unpatentable over Probst in view of the UK '755 as applied to claims 1 and 11 above and further in view of Murray. This rejection is traversed.

The Examiner states:

"Claims are considered to be met by Probst combined with UK reference as explained and applied above rejections except that either Probst or UK reference does not define the sleeve, the upright and the cross member end flanges of the apparatus having bores being aligned together and a pin being engaged through the aligned bores for securing the upright, the cross member together. Murray teaches a safety device comprising an arm being secured to a building roof, a vertical sleeve latterly mounted on the arm, and an upright post (12) having lower end being received into the vertical sleeve, wherein the vertical sleeve and the lower end of the upright post having bores being aligned each other and a pin being engaged through the aligned bores for securing the upright post to the vertical sleeve. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the roof retaining apparatus of Probst combined with UK reference having the upright and the sleeves having bores aligned each other to receive a pin as taught by Murray as an old and well know connecting mechanism for removably and adjustably mounting two structural elements together."

Murray actually teaches:

"A safety rail system for installation about the perimeter of a rooftop work site comprises a plurality of stanchion supporting bases for attachment to existing building structure, a plurality of stanchions removably held by the bases and having cable=receiving links thereon, and a pair of wire rope cable safety rails supplied by a pair of winches fixed to at least one of the stanchions. the bases include a pair of plate members connected by a hinge for adjustable attachment to a vertical wall surface of the building and another

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structural surface forming an edge with the vertical wall surface. A vertically extending sleeve is fixed to the plate member which attaches to the vertical wall surface of the building for slidably receiving a bottom portion of a stanchion, and a transversely extending locking pin is used to retain the bottom portion of the stanchion within the sleeve. The safety rail cables are unwound from their respective winches and connected to the stanchions using the cable receiving links, then tensioned using the winches."

Applicant does not have a hinged plate with a sleeve thereon for receiving an upright at a position along a vertical edge or surface of a structure - nor does he use the uprights for engaging a wire forming a perimeter about an entire periphery of a roof.

Here, again, as in all the §103 rejections above issued by the Examiner, the Examiner is using hindsight to perform a reconstruction of applicant's structure, according to the "blueprint" applicant has provided. In no instance has there been any MOTIVATION, TEACHING OR SUGGESTION in any of the art to go through the twists and turns the Examiner uses trying to make the prior art fit applicants mold.

First, as stated clearly in King Instrument Corp., v. Otari Corp., 226 USPQ 402 (Fed. Cir. 1985):

"In the absence of evidence that suggests the desirability of combining references in a proposed manner, such combination is not available to preclude patentability under 35 USC 103."

and also: Ashland Oil, Inc., v. Delta Resins & Refractories, Inc., 227 USPQ 657 (Fed. Cir. 1985)

"To combine references (A) and (B) properly to reach the conclusion that the subject matter of a patent would have been obvious, case law requires that there must be some teaching, suggestion, or inference in either reference (A) or (B), or both, or knowledge generally available to one of ordinary skill in the relevant art that would lead one skilled in the art to combine the relevant teachings in the references (A) and (B). Consideration must be given to teachings in the references that would have led one skilled in the art away from the claimed invention. A claim cannot properly be used as a blueprint for extracting individual teachings from the references."

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and also: In re Fritch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988)

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

this is not allowable.

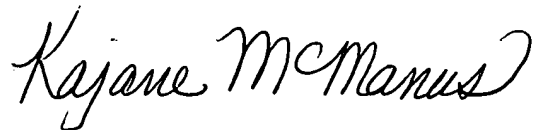
Second, all the Examiner's attempts fail miserably and the Examiner still has not found anything to deprecate the patentability of applicant's structure over the cited art. Here see: Ex parte Clapp, 227 USPQ 972 (B.P.A.I. 1985)

"Presuming arguendo that the references show the elements or concepts urged, the Examiner presented no line of reasoning as to why the artisan reviewing only the collective teachings of the references would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. In the instant application, the Examiner has done little more than cite references to show that one or more elements or some combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of element. That is to say, the appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The Board found nothing in the references that would expressly or impliedly teach or suggest the modifications urged by the Examiner. Additionally, the Board found no line of reasoning in the answer as to why the artisan would have found the modifications urged by the Examiner to have been obvious. Based upon the record, the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide."

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All rejections are believed overcome and an early allowance is
awaited.

Respectfully submitted,

A handwritten signature in cursive script that reads "Kajane McManus". The signature is written in dark ink and is positioned above the printed name and registration number.

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